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**NOTICE OF APPEAL FROM THE EXAMINER TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket Number (Optional)

112740-1017

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on _____

Signature _____

Typed or printed
name _____

In re Application of
Peter Neumann

Application Number
10/511,457

Filed
October 15, 2004

For DISASTER AND EMERGENCY MODE FOR MOBILE...

Art Unit
2683

Examiner
Kiet M. Doan

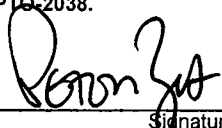
Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ 500.00

- ☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ _____
- ☐ A check in the amount of the fee is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 02-1818. I have enclosed a duplicate copy of this sheet.
- ☒ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 48,196
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34: _____



Signature

Peter Zura

Typed or printed name

312-807-4208

Telephone number

June 6, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Doc Code: AP.PRE.REQ

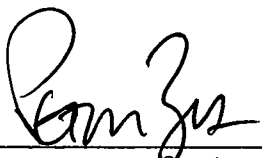
PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		112740-1017	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number	Filed	
	10/511,457	October 15, 2004	
	First Named Inventor		
	Peter Neumann		
	Art Unit	Examiner	
	2683	Kiet M. Doan	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 48,196 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of _____ forms are submitted.</p>			



Signature
Peter Zura

Typed or printed name
312-807-4208

Telephone number
June 6, 2006

Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Peter Neumann
Appl. No.: 10/511,457
Conf. No.: 9884
Filed: October 15, 2004
Title: DISASTER AND EMERGENCY MODE FOR MOBILE TELEPHONES
Art Unit: 2683
Examiner: Kiet M. Doan
Docket No.: 112740-1017

Director of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated December 6, 2005 and Advisory Action dated April 6, 2006. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

Claims 9-16 are pending in the present application. Independent claims 9, 15 and 16 are the focus of this request. Applicant respectfully submits the rejection is improper and requests reversal by this board.

Claims 9, 15 and 16, along with dependent claims 10-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Wizgall et al.* (US Patent No. 5,630,209) in view of *Hoirup et al.* (US Patent No. 6,397,054). The Applicant respectfully traverses the above rejections for the following reasons.

The Applicant respectfully maintains that there is no motivation to combine the cited references as suggested by the Examiner, and even if the combination is made, the combination does not teach or suggest the above feature. Specifically, the cited art fails to teach or suggest “a connection only being established from a mobile station in disaster area to a destination called by the mobile station if the mobile station requesting the connection establishment communicates a sequence” as recited in claim 9 and similarly recited in claim 15. Likewise, the cited art does not teach or suggest a mobile station comprising “parts for receiving, in an event of a disaster in an area in which the mobile station is present, a sequence transmitted in a message sent to the mobile station in at least one cell of a mobile radio network present in the area; and parts for transmitting the sequence with a request for establishment of a connection to a destination to the mobile radio network” as recited in claim 16.

The present claims are directed to addressing the issues of mobile radio networks in an area hit by a disaster, where the networks are frequently overloaded due to users of numerous mobile stations present in the area trying to make emergency calls. To alleviate such problems, the present claims disclose a configuration where, for example, a sequence is transmitted via a cell broadcast (e.g., SMS-CB in GSM, etc.) to all mobile stations in at least one cell in the area of the disaster, wherein the sequence allows a mobile station to request the establishment of a connection (e.g., a voice connection) to a destination address. Accordingly, the establishment of connections can be more efficiently controlled to the mobile stations in an area while still avoiding network overload.

Regarding *Wizgall*, the reference teaches an emergency call system that permits everyone to transmit an emergency call with a report of an emergency and request specific assistance (col. 2, lines 51-54). Under the teaching of *Wizgall*, a cell phone pre-stores “emergency data” on a memory card (CC) that contains information such as medical data or alarm category and transmits this data repeatedly over an emergency channel (col. 4, line 53 - col. 5, line 14; col. 9, lines 14-22). Once the emergency call is received, the response center may evaluate the data for proper response and warn others of the emergency (col. 5, lines 5-31). Thus, it is clear from the teaching of *Wizgall*, that no sequence is transmitted in a message sent to the mobile station(s) of a cell in the area of the disaster (see claim 16: “receiving . . . a sequence”), where a connection can only be established from a mobile station in disaster area to a destination called by the mobile station if the mobile station requesting the connection establishment communicates a sequence (see claim 16: “transmitting the sequence with a request for establishment of a connection to a destination to the mobile radio network”). Also, the emergency data read from the memory card in *Wizgall* is meant only for transmission, not for requesting a call connection. Additionally, emergency data (i.e., personal data) is transmitted, not the claimed sequence.

In light of these deficiencies, the Examiner turned to the *Hoirup* reference. However, *Hoirup* fails to solve the deficiencies of *Wizgall*, discussed above. Specifically, *Hoirup* addresses issues of SMS restrictions in GSM networks when users wish to make emergency calls (col. 1, lines 52-63; col. 2, lines 5-16). In order for users to make non-voice emergency calls (i.e., SMS, see col. 2, line 62 - col. 3, line 8), *Hoirup* introduces a new cause and service type to the GSM system to allow a user to receive an assignment message during a channel request, where a CM service request recognizes emergency SMS messages over a dedicated channel (col. 5, lines 8-29; see claim 1). However, *Hoirup* teaches an emergency calling procedure for a GSM-based system that does not include the use of a sequence, as claimed. In Figs. 1 and 3 of *Hoirup*, an emergency calling procedure is initiated from a mobile station by transmitting a CHANNEL REQUEST message to the cellular or satellite network. In response to the CHANNEL REQUEST, the network sends an IMMEDIATE ASSIGNMENT message to the mobile station, directing it to a dedicated control channel on which a call setup can proceed (col. 2, lines 17-39; see col. 5, lines 30-52). Accordingly, *Hoirup* teaches that the request is the first

message exchanged in the displayed message flow, and as such, cannot contain a sequence that was transmitted before the request.

Furthermore, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Wizgall* and *Hoirup* references in the manner suggested in the Office Action. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

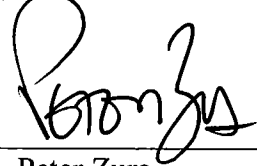
Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

As discussed above, *Wizgall* teaches to pre-store emergency data on a memory card and transmits this data repeatedly over an emergency channel. Once the emergency call is received, the response center may evaluate the data for proper response and warn others of the emergency. In contrast, *Hoirup* introduces a new establishment cause and service type to a GSM system to allow a user to receive an assignment message during a channel request, where a CM service

request recognizes emergency SMS messages over a dedicated channel. First of all, there is nothing taught or suggested in *Wizgall* that would motivate a person skilled in the art to develop an entirely new establishment cause and service type to a GSM system to allow emergency SMS messages. Second of all, the configuration in *Wizgall* teaches that the emergency call is already in progress when the emergency data is read and thus teaches away from the disclosure of *Hoirup*, which uses SMS messaging to communicate the emergency (see *Wizgall*, col. 8, lines 13-22). Also, the purpose of the emergency data in *Wizgall* is to supplement an existing emergency call by subsequently transferring this data to ensure that, in cases where the user is incapacitated, the response center receives information on the user (see col. 8, lines 23-25). Accordingly, there is no reason why one skilled in the art, after considering the teaching in *Wizgall*, would turn to the configuration in *Hoirup*.

In light of the above, Applicant respectfully submits that independent claims 9, 15 and 16 of the present application, as well as all claims which respectfully depend therefrom, are both novel and non-obvious over the art of record. Accordingly, Applicant respectfully requests the rejection be reversed and that a timely Notice of Allowance be issued in this case. If any fees are due in connection with this application as a whole, the office is hereby authorized to deduct said fees from Deposit Account No.: 02-1818.

Respectfully submitted,
BELL, BOYD & LLOYD LLC

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Dated: June 6, 2006